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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,296	01/20/2000	Scott Trees	BAL6019P0021US	4240

7590

03/13/2003

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
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CHICAGO, IL 60661-2511

EXAMINER

MCCORMICK, SUSAN B

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 03/13/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/488,296

Applicant(s)

TREES ET AL.

Examiner

Susan B. McCormick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 114/2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **Detailed Action**

The amendment and I.D.S. has been acknowledged and entered on December 26, 2002 and January 21, 2003 in paper nos. 10, 11 and 12 respectively.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### **Drawings**

Applicant requests to hold the petition to accept colored drawings in abeyance until notification of allowance of the current application. Applicant is reminded that post allowance communication may delay the issuance of a patent.

### **Information Disclosure Statement**

The I.D.S. has been received and acknowledged in papers no. 11 and 12.

### **Claims**

Claims 1- 40 have been canceled by Applicant in paper no. 10 and new claims 41-61 have been added.

### **Claim Rejections- 35 U.S.C. § 112**

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 59-61 (new) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 59-61 (new) lack antecedent basis for "the plant." This rejection could be obviated by amending the claims to depend on claim 57.

#### Enablement

Claim 42 (new) is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as previously stated for claim 2 (paper 9, pp. 2-3).

The invention employs novel plants. Since the plants are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If they are not so obtainable or available, the requirements of 35 U.S.C. § 112, regarding "how to make" the invention, may be satisfied by deposit. For each plant, a deposit of 2500 seeds is considered adequate to ensure availability of each claimed embodiment. If the plant does not breed true by seeds, then deposit of some other type of plant material is required. Applicant teaches a method for making plants with striped flowers. However, since mutagenesis is a random process, the odds of reproducing exactly the same plant are astronomical. Therefore, the Applicant must deposit the specifically claimed lines, 1865 and 2581. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific plant line has been deposited under the Budapest Treaty and that it will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If the deposit is not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809, Applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

(a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;

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(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer; and,

(d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and,

(e) the deposit will be replaced if it should ever become inviable.

Applicant's willingness to make acceptable deposits is noted.

#### Written Description

Claims 41-61(new) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to New Guinea impatiens having a striped pattern on at least one petal and subsequent generations thereof cultivars.

The issue at hand is whether Applicant was in possession of the claimed invention at the time the application was filed. In analyzing whether the written description requirement is met for genus claims, it is determined whether a representative number of species have been described. In this case, the two disclosed embodiments are not representative of the enormous number of products claimed. Applicant is claiming all things (i.e. pollen, ovules, cuttings, etc.) and New Guinea impatiens can vary widely in flower morphology, flower color, leaf morphology, pest resistance and many other characteristics. Since these traits vary independently, the claims encompass millions of plants having unique combinations of phenotypic characteristics. The specification only provides a complete description of 1865 and 2581. Therefore, Applicants are not in possession of the claimed genus.

#### Claim Rejections- 35 U.S.C. 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 41-44, 46-49, 51-54, 57-59, 61 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cosner, as previously stated for claim 2, 11-13, 15, 19-21 and 23, (paper 9, pp. 4-5). Cosner discloses New Guinea impatiens plants having striped petals (referred to as "marbled"). See Figs. 2 and 3; col. 9, lines 2-4. Cuttings (col. 20, lines 34-37), pollen and ovules (col. 23, lines 17-25) are also disclosed. The claims do not recite any other characteristic that would distinguish the claimed plants from those of the prior art. Even if the claimed plants possess some characteristic not possessed by those of Cosner, the invention would still be obvious because Cosner teaches that mutagenesis are commonly used to produce sports (col. 2, l. 56-60).

The courts have approved the use of 102/103 rejection for product-by-process claims. See MPEP 2113.

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Claim Rejections- 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41, 45, 47, 50, 52, 55, 57-60 (new) are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosner in view of Stephens et al., as previously stated for claims 1, 5, 11, 14, 19 and 22, (paper 9, p. 5). Cosner teaches New Guinea impatiens having striped flowers. Cosner does not teach cultures of regenerable cells from these plants. Stephens et al. teach using tissue culture in New Guinea impatiens as a means of asexual propagation (pg. 163).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to propagate the plants of Cosner using tissue culture as taught by Stephens et al., with the advantages being: maintaining a virus-free stock, breeding programs can quickly be increased, certain genotypes are difficult to propagate by conventional methods and using less space (Stephens et al., pg. 165). Thus the invention as a whole was clearly prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

No claim is allowed.

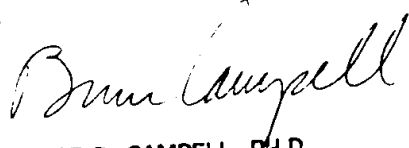
Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm

  
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